

REMARKS

Amendments

Claim 1 is amended to correct the typographical error in the definition of A² and A³ and to define B as 2,6-disubstituted trans-decalin. Additionally, claim 1 is amended to delete reference to "carboxylic acid derivative." Claims 2, 8 and 12 are amended to be consistent with the language of amended claim 1. Claims 6, 11, and 13 are amended to use language in accordance with conventional US practice. Claims 7 and 8 are amended to provide express antecedent basis for terms recited in claims 8 and 9, respectively. Claims 9, 16, 21 and 23 are amended to delete "equivalents." New claims 24-25 are directed to further aspects of applicants' invention and are supported throughout the disclosure.

Withdrawal of the Restriction

Applicants gratefully acknowledge the Examiner's withdrawal of the Restriction Requirement (Lack of Unity Objection).

Objection to Claim 1

The typographical error in the definition of A² and A³ is corrected by the above amendments. Withdrawal of the objection is respectfully requested.

Rejection of Claim 1 under 35 USC 112, first paragraph

Claim 1 is rejected as allegedly being non-enabled. This rejection is respectfully traversed. In the rejection, it is acknowledged that applicants' claims are enabling with respect to conversion of compounds of formula II in which X is halogen. However, it is asserted that the claims are not enabling when X is O. Applicants disagree.

Beginning at page 10, line 29, applicants' specification describes in detail a reaction procedure in which X is O and B is decaliny. See also example 6 in which the starting material of formula II is 6-n-propyl-trans-decalin-2-one. These disclosures provide more than sufficient guidance to use the claimed invention with at most routine experimentation.

Withdrawal of the rejection is respectfully requested.

Rejection of Claims 1-23 under 35 USC 112, first paragraph

Claims 1-23 are rejected as allegedly being non-enabled. This rejection is respectfully traversed. In the rejection, it is acknowledged that applicants' claims are enabling with respect to conversion of compounds of formula II in which m and n are 0. However, it is asserted that the claims are not enabling when m and n are 1. Applicants disagree.

The rejection asserts that certain intermediates are "rare, and results are unpredictable." This assertion is conclusory. No evidence is cited in support of this assertion. Even if a class of compounds are said to be "rare," does not mean such compounds are unavailable.

The text bridging pages 5 and 6 of applicants' specification describe preparation of compounds of formula II. Reactions involving phenols of formula III are known. See, e.g., page 10, lines 19-27.

Applicants specification provide more than sufficient guidance to enable one of ordinary skill in the art to carry out the process using compounds wherein m and n are 0, as well when m and n are 1. See, for example, scheme I set forth at page 8 and the subsequent description of performing the process according to scheme I, and scheme II set forth at page 10 and the subsequent description of performing the process according to scheme II.

Applicants respectfully submit that it is the initial burden of the PTO to establish a reason to doubt the truth of the statements presented in the specification concerning utility and/or how to use. See, e.g., *In re Marzocchi et al.*, 169 USPQ 367, 370 (CCPA 1971) (A...it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure. In addition, as stated in the specification *Marzocchi* decision:

"a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of section 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support" (emphasis in original).

See *In re Marzocchi*, at 369. See also *In re Brana*, 51 F.3d 1560 (Fed. Cir. 1995).

The only relevant concern of the Patent Office should be over the truth of assertions relating to enablement. The first paragraph of section 112 requires nothing more than **objective** enablement. See *In re Marzocchi, supra*. The Examiner has provided no support for establishing that one of ordinary skill would doubt the objective truth of the asserted enablement disclosure provided by the specification.

In view of the above remarks, it is respectfully submitted that applicants' specification provides sufficient guidance to objectively enable one of ordinary skill in the art to practice the claimed invention using no more than routine experimentation. Withdrawal of the rejection is respectfully requested.

Rejection under 35 USC 112, second paragraph

Claims 1-7, 9-10, 18, and 21 are alleged to be indefinite for failure to recite steps the Examiner considers essential, namely conversion of carboxylic acid into a carboxylic acid salt. However, the carboxylic acid derivative recited in claim 1 encompassed carboxylic acid salts. In any event, claim 1 recites converting a compound of formula (II) into a carboxylic acid or a salt of a carboxylic acid.

Claims 8, 19, and 20 are alleged to be indefinite with respect to the "carboxylic acid derivative." As described in the specification, the carboxylic acid derivative can be a carboxylic acid or a salt thereof. See, e.g., page 5, lines 8-16 and page 8, lines 21-23. The bis(alkylthio)carbenium salt recited in claim 8 is merely a certain type of carboxylic acid salt. The description of other types of carboxylic acid derivatives at page 10, lines 12-17 does not render that term carboxylic acid derivative indefinite.

In any event, the claims are amended above to delete the term "carboxylic acid derivative"," solely for purposes of furthering prosecution Withdrawal of the rejection is respectfully requested.

Additionally, claim 1 is said to be indefinite as to the phrase "introduction of a C1 unit." While applicants respectfully submit that this language is sufficiently definite, especially in the context of applicants' claims, the phrase has been deleted solely for purposes of furthering prosecution.

Finally, claim 9 is said to be indefinite as to "halonium equivalents." Here again, applicants respectfully submit that this language is sufficiently definite, especially in the context of applicants' claims. However, solely for purposes of furthering prosecution, equivalents has been deleted from the claims.

Withdrawal of the rejection is respectfully requested.

Rejection under 35 USC 103(a)

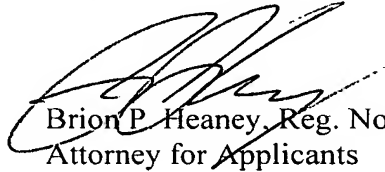
Claims 1-6 are rejected as allegedly being obvious in view of the excerpt from John McMurray, *Organic Chemistry*, 2nd edition, regarding Grignard reactions. This rejection is respectfully traversed.

McMurray described a carboxylation of aromatic Grignard reagent, i.e., 1-Bromo-2,4,6-trimethylbenzene is converted into 2,4,6-trimethylbenzoic acid. McMurray provide no disclosure or suggestion of a Grignard reaction involving a cyloaliphatic ring system such as 2,6-disubstituted trans-decalin. Nothing in the McMurray disclosure would lead one to a reaction process involving a cyloaliphatic ring system as recited in applicants' claimed invention.

In view of the above remarks, withdrawal of the rejection under 35 USC 102 is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Brion P. Heaney', is written over the typed name and title.

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